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| IBM ST-SVL SAWYER LAW GROUP LLP 2465 E. Bayshore Road, Suite No. 406 PALO ALTO, CA 94303 | | | EXAMINER | |
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AALIM LAKHANI and VICTOR CHAN

Appeal 2008-0850
Application 09/943,061
Technology Center 2100

Decided: August 20, 2008

Before JAMES D. THOMAS, JEAN R. HOMERE,
And ST. JOHN COURTENAY III, *Administrative Patent Judges*.
THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. 134(a) from the Examiner's final rejection of claims 1 through 25. We have jurisdiction under 35 U.S.C. § 6(b).

The following references are relied on by the Examiner:

| | | |
|---------|-----------------|---------------------------------|
| Wyatt | US 6,041,411 | Mar. 21, 2000 |
| Mikurak | US 6,606,744 B1 | Aug. 12, 2003 |
| | | (filing date November 22, 1999) |

Claims 1 through 25 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Mikurak in view of Wyatt.

Rather than repeat the positions of the Appellants and the Examiner, we refer to the Brief for Appellants' positions, and to the Answer for the Examiner's positions.¹

We reverse the outstanding rejection under 35 U.S.C. § 103 because the subject matter encompassed by the claims on appeal must be reasonably understood without resort to speculation. Presently, speculation and conjecture must be utilized by us and by the artisan inasmuch as the claims on appeal do not adequately reflect what the disclosed invention is. Note *In re Steele*, 305 F.2d 859, 862 (CCPA 1962). Note also *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

¹ The Examiner's Answer in the present appeal was mailed on November 27, 2006, and the Reply Brief was filed on March 16, 2007. In the communication from the Examiner mailed on August 9, 2007, the Examiner considered this Reply Brief to be untimely and it was not considered. The Board's Docketing Notice mailed on December 11, 2007 indicates that no Reply Brief has been filed. The Reply Brief appears not to be in compliance with 37 C.F.R. § 41.41(a)(1).

Because we conclude that there are significant ambiguities with respect to each independent claim 1, 10, 15, and 17, and therefore their respective dependent claims, we reject all claims on appeal, claims 1 through 25, under the second paragraph of 35 U.S.C. § 112, pursuant to our authority under 37 C.F.R. § 41.50(b).

Our focus is upon clause (c) of each independent claim which recites a resolution module “for resolving . . . by accessing the packaged data correlated to the selected unresolved package.” This language was added by an amendment on March 19, 2004, which has been retained in subsequent versions of this claim to the present version on appeal. Justification for these amendments to the claims on appeal is provided at page 10 of the amendment.

Part of the justification relies on the discussion at page 9, line 4 to page 10, line 15 of the Specification as exemplary teachings. All claims on appeal are considered to be indefinite because they fail to particularly point out and distinctly claim what Appellants regard as their invention. The last clause of each independent claim on appeal asserts the resolving capability of the resolution module is performed by merely accessing package data correlated to a selected unresolved package. The noted discussion at pages 9 and 10 of the Specification as filed does not support the mere accessing of package data to justify the assertion that resolution actually occurs by the resolution module. The discussion with respect to this module at page 11 of the Specification as filed requires that the customer select attribute values for a selected product and not the mere accessing of data items associated therewith for resolution to occur. Moreover, the functionality discussed at

pages 9 and 10 of the Specification that was filed may be construed by the reader to relate to the selection module rather than the resolution module. Even here, the customer is required to select a catalog entry associated with an unresolved package. Thus, all claims on appeal remain misdescriptive of the disclosed invention and/or otherwise incomplete.

Separately, we also reject claims 1 through 25 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter within the provisions of 37 C.F.R. 41.50(b). Independent claim 1 recites an “e-commerce system.” Independent claim 10 recites in its preamble an “e-commerce method.” Independent claim 15 recites a “program product” that is further stated to be comprised of certain features recited in the body of the claim. A similar approach is recited in the preamble of independent claim 17 that states a “computer-readable signal bearing medium . . . comprising the instructions of.”

Based upon our assessment of the disclosed invention, the same features are essentially recited in the body of each independent claim on appeal. These are the recited catalog database, a selection module, and a resolution module in claim 1. Similarly features are recited in equal terms in independent claim 15. The actual functionality is recited in method independent claim 10 and independent claim 17. Among claims 1 through 25, the actual methodology according to the preamble and the body of each independent claim, for example, does not require the use of a machine or otherwise recite a machine or computer implemented method, thus presenting a situation where a human being may perform the recited functionalities in the body of each claim. If it may be fairly stated that the

method may produce a concrete, useful, and tangible result, the result is still operations upon data constructs or data structures themselves by software elements characterized as modules or otherwise. There is no transformation of any underlying tangible subject matter to a different state or thing. Note the reasoning in *In re Comiskey*, 499 F.3d 1365, 1377-79 (Fed. Cir. 2007). These considerations flow through to the dependent claims as well.

In a corresponding manner, the so-called product independent claim 15 and signal media independent claim 17 recite the same methodology as the other independent claims. The computer-readable medium is not positively recited to be used or executed by the processor noted in the preamble to perform a methodology, but merely that it is for enabling the purchase of a package, the purchase of which is not actually recited in the independent claims on appeal. Independent claim 15 appears to directly claim the program itself as a product. No authority that we are aware of permits within 35 U.S.C. § 101 the claiming of a computer program itself as an article of manufacture. Any signal or transmission embodiment, such as in independent claim 17, is also proscribed by the reasoning in *In re Nuijten*, 500 F.3d 1346, 1359 (Fed. Cir. 2007).

In summary, we have reversed the rejection of all claims on appeal under 35 U.S.C. § 103. Once properly definite claims are presented as a result of any subsequent prosecution in this application, the actual prior art applied by the Examiner in this appeal may also be appropriate should that arise. Additionally, any other prior art may be appropriate to apply as well. We have introduced two new grounds of rejection within 37 C.F.R.

§ 41.50(b). These include a rejection of all claims on appeal, claims 1 through 25, under the second paragraph of 35 U.S.C. § 112, as well as a separately stated rejection of these claims under 35 U.S.C. § 101.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

pgc

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